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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,803	09/28/2006	Alfred Thomas	247079-000238USPX	6715
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NIXON PEABODY LLP 300 S. Riverside Plaza 16th Floor CHICAGO, IL 60606			EXAMINER LEICHLITER, CHASE E	
			ART UNIT	PAPER NUMBER
			3714	
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			05/14/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/594,803	Applicant(s) THOMAS, ALFRED	
	Examiner CHASE LEICHLITER	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,8,9,11,12,14,16-21,24,25,39-41 and 45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,8,9,11,12,14,16-21,24,25,39-41 and 45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>01/05/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 1, 2, 5, 8, 9, 11, 12, 14, and 16 are rejected under 35 USC 101 as being directed to non-statutory subject matter because these are method or process claims that do not transform underlying subject matter (such as an article or materials) to a different state or thing, nor are they tied to another statutory class (such as a particular machine). See Diamond v. Diehr, 450 U.S. 175, 184 (1981) (quoting Benson, 409 U.S. at 70); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978) (citing Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)). See also In re Bilski (Fed Cir, 2007-1130, 10/30/2008) where the Fed. Cir. held that method claims must pass the "machine-or-transformation test" in order to be eligible for patent protection under 35 USC 101.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 8, 11, 12, 17, 20, 24, 25, and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Boesen et al. (US 2002/0151354).

Regarding claim 1, Boesen teaches a method for playing a wagering game on a gaming terminal comprising:

- Conducting a wagering game having a randomly selected outcome (P11);

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- Awarding a player a payout amount in response to the randomly selected outcome being one of a plurality of winning outcomes (P11);
- And Increasing the amount of the multi-terminal prize pool in response to the randomly selected outcome being a multi-terminal prize-pool increasing outcome (P11 and P12).

Regarding claim 17, Boesen teaches a gaming system comprising:

- A controller (P11);
- A plurality of gaming terminals coupled to the controller, each of the plurality of gaming terminals having a wagering game having a plurality of symbols that indicate a randomly selected outcome of the wagering game, and a prize pool (P11 and P12);
- And in response to one of the randomly selected outcomes at one of the plurality of gaming terminals being one of a plurality of winning outcomes, the one of the plurality of gaming terminals awarding the player a payout amount, and, in response to the randomly selected outcome at one of the plurality of gaming terminals being a prize-pool increase outcome, the one of the plurality of gaming terminals increasing the amount of the prize pool (P11 and P12).

Regarding claim 39, Boesen teaches a gaming terminal comprising:

- A wagering game having a plurality of symbols that indicate a randomly selected outcome of the wagering game (P11 and P12);
- A first prize pool (P11);

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- And wherein, in response to the randomly selected outcome being one of a plurality of prize- pool increase outcomes, the gaming terminal increases the amount of the first prize pool (P11).

Regarding claim 2, Boesen teaches the randomly selected outcome comprises a at least one symbol (P12).

Regarding claim 8, Boesen teaches the conducting, awarding, and increasing steps are performed by a controller connected to each of the plurality of gaming terminals (P11 L3-5).

Regarding claim 11, Boesen teaches awarding the multi- terminal prize pool in response to the randomly selected outcome being a multi-terminal prize- pool award outcome (P15).

Regarding claim 12, Boesen teaches each of the plurality of gaming terminals includes a terminal-level prize pool and further comprising increasing the terminal- level prize pool at one of said plurality of gaming terminals in response to the randomly selected outcome being a terminal-level prize pool at said one of said plurality of gaming terminals (P11 and P12).

Regarding claim 20, Boesen teaches the prize pool is a terminal-level prize pool (P11 and P12).

Regarding claim 24, Boesen teaches the prize pool is awarded when the randomly selected outcome is a predetermined one of the plurality of winning outcomes (P15).

Regarding claim 25, Boesen teaches the randomly selected outcome comprises at least one symbol and the amount the prize pool is increased depends on which of the at least one symbols is achieved (P11, occurrence of a predetermined prize would include a specific symbol or symbol set).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 18, 19, 21, 40, 41, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boesen et al. (US 2002/0151354) in view of Jackson et al. (US 7481430).

Regarding claim 18, Boesen fails to teach the multi-terminal prize pools including a bank-level prize pool and a wide-area network prize pool.

However, Jackson teaches a similar wagering game as Boesen having multiple jackpots. Jackson teaches the limitation of the multi-terminal prize pools including a bank-level prize pool and a wide-area network prize pool (C3 L4-15, jackpots can be based off of a network of machines or an individual machine).

Regarding claim 19, Boesen teaches in response to the randomly selected outcome being the prize-pool increase outcome (P11 and P12) but fails to teach the controller increases the amount of at least one of the plurality of multi-terminal prize pools.

However, Jackson teaches a similar wagering game as Boesen having multiple jackpots. Jackson teaches the limitation of the controller increases the amount of at least one of the plurality of multi-terminal prize pools (C1 L46-56).

Regarding claim 21, Boesen teaches the basic game comprises the player wagering a wagering amount on the basic game (P173), and in response to the randomly selected outcome being the prize-pool increase outcome (P11) but fails to teach the prize pool is increased by a percentage of the wager amount.

However, Jackson teaches a similar wagering game as Boesen having multiple jackpots. Jackson teaches the limitation of the prize pool is increased by a percentage of the wager amount (C1 L46-56).

Regarding claim 40, Boesen teaches prize-pool increase outcomes increase the first prize pool (P11 and P12) but fails to teach that a plurality of prize-pool increase outcomes increases the first prize pool by a different amount.

However, Jackson teaches a similar wagering game as Boesen having multiple jackpots. Jackson teaches the limitation of a plurality of prize-pool increase outcomes increases the first prize pool by a different amount (C1 L46-56, different outcomes from Boesen could increase the prize pool by a different percentage as taught by Jackson).

Regarding claim 41, Boesen teaches in response to the randomly selected outcome being one of a plurality of prize- pool increase outcomes (P11 and P12) but fails to teach a second prize pool and the gaming terminal increases the amount of the first or second prize pools.

However, Jackson teaches a similar wagering game as Boesen having multiple jackpots. Jackson teaches the limitations of a second prize pool (C1 L46-56) and the gaming terminal increases the amount of the first or second prize pools (C1 L46-56, wager determines which pool is increased).

Regarding claim 45, Boesen fails to teach each of the plurality of winning outcomes includes a plurality of symbols, and at least one of the symbols is a "break the bank" symbol.

However, Jackson teaches a similar wagering game as Boesen having multiple jackpots. Jackson teaches the limitation of each of the plurality of winning outcomes includes a plurality of symbols, and at least one of the symbols is a "break the bank" symbol (C1 L17-18, special symbols and triggering events from such symbols are known).

7. Therefore Boesen and Jackson are analogous art because they teach similar wagering games offering jackpots to players. It would have been obvious to one of

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ordinary skill in the art to combine Boesen and Jackson because one would be motivated to provide increased user interest by always having at least one jackpot having a large payout when operating multiple jackpots. All the claimed elements were known in the prior art and one skilled in the art could have provided a method for a second jackpot by known methods with no change in their respective functions, and the combination would have yielded predictable results.

8. Claims 5, 9, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boesen et al. (US 2002/0151354) in view of Olsen (US 6217448).

Regarding claim 5, Boesen fails to teach receiving player-identification information, the awarding step comprising crediting an amount to a player account indicated in the player-identification information.

However, Olsen teaches a similar wagering game as Boesen having linked machines and a jackpot. Olsen teaches the limitation of receiving player-identification information, the awarding step comprising crediting an amount to a player account indicated in the player-identification information (C15 L26-38).

Regarding claim 9, Boesen teaches inputting a wager amount on the wagering game by the player (P173), and, wherein, in response to the randomly selected outcome being the multi-terminal prize-pool increasing outcome (P11) but fails to teach the multi-terminal prize pool is increased by an amount equal or greater than the wager amount.

However, Olsen teaches a similar wagering game as Boesen having linked machines and a jackpot. Olsen teaches the limitation of the multi-terminal prize pool is increased by an amount equal or greater than the wager amount (C9 L52-54).

Regarding claim 14, Boesen fails to teach awarding the terminal-level prize pool for a limited amount of time or a limited number of gaming sessions.

However, Olsen teaches a similar wagering game as Boesen having linked machines and a jackpot. Olsen teaches the limitation of awarding the terminal-level prize pool for a limited amount of time or a limited number of gaming sessions (Abstract L1-7).

Regarding claim 16, Boesen fails to teach the multi-terminal prize pool is a restricted-access wagering game.

However, Olsen teaches a similar wagering game as Boesen having linked machines and a jackpot. Olsen teaches the limitation of the multi-terminal prize pool is a restricted-access wagering game (C15 L26-38, system determines player eligibility).

9. Therefore Boesen and Olsen are analogous art because they teach similar wagering games having linked machines and a jackpot. It would have been obvious to one of ordinary skill in the art to combine Boesen and Olsen because one would be motivated to provide increased user interest by using a player card a player will increases comps and become eligible for a jackpot while playing. All the claimed elements were known in the prior art and one skilled in the art could have provided a method for player identification by known methods with no change in their respective functions, and the combination would have yielded predictable results.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Weingardt et al. (US 5275400).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHASE LEICHLITER whose telephone number is (571)270-7109. The examiner can normally be reached on Monday through Friday 9am to 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571)272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. L./
Examiner, Art Unit 3714

/Dmitry Suhol/
Supervisory Patent Examiner, Art
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